

Appl. No. 09/906,995

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REMARKS

Claims 1-3 and 5-9 are pending in the present application. Claim 8 is amended by this amendment to clarify the subject matter recited therein. No new matter is added by the amendment, which finds support throughout the specification and figures. It is respectfully submitted that the amendment does not require additional search and or consideration, simplifies issues for appeal, and/or places the claim in condition for allowance. Therefore it is respectfully requested that the amendments be entered. In view of the amendments and the following remarks, reconsideration of the present application is respectfully requested.

The Specification is objected to under 35 U.S.C. § 132 as allegedly adding new matter into the disclosure. Claims 8 and 9 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse.

The Examiner asserts that claim 8 as amended requires that both conditions, 1) whether an employees has made a reservation ... and 2) comparison between a working date ..., must be satisfied due to the "and" which separates the two features. However, the phrase that precedes the two alternatives, "one of," clearly prescribes that only one condition need be satisfied, regardless of whether the elements are separated by an "and" or an "or". This conclusion is clearly supported by referring to the logical reduction of the formulation, namely "one of A or B", which is satisfied if either A or B is true. Claim 8 as presented does not add new matter and is supported in the specification. Therefore, it is respectfully requested that the objection and rejections based on the amendments to claim 8 be withdrawn.

Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being unpatentable over Brower, Helen; "Business Travel-corporate plans; JAL develops bonus program that companies bank on"; Travel Weekly (hereinafter referred to as Brower). Applicants respectfully traverse.

**Appl. No. 09/906,995**

Claim 8 relates to a method of performing a mileage service depending on a distance traveled by a vehicle covered by the mileage service. The method according to claim 8, includes the feature of, *inter alia*, determining whether usage of the vehicle covered by the mileage service is for a business of a corporation, *based on a comparison between a working date and a working location of the employee and one of a date of reserving and a period of using the vehicle covered by the mileage service*. The method of claim 8 further includes, if the vehicle covered by the mileage service is reserved for the business of the corporation, giving earned miles to the corporation, and if the vehicle covered by the mileage service is not reserved for the business of the corporation, giving earned miles to the employee. The Examiner states that the unamended claim provides four alternatives (Office Action; page 10, lines 20-21). However, it is respectfully submitted that the unamended claim provided two alternative limitations, and two method steps which are not presented in the alternative, but which have mutually exclusive conditions that correspond to each of the two alternatives. Furthermore, as amended, claim 8 presents a single determination and the same two method steps.

It is respectfully submitted that none of the cited reference discloses, or even suggests, the feature of determining whether usage of the vehicle covered by the mileage service is for a business of a corporation, based on a comparison between a working date and a working location of the employee and one of a date of reserving and a period of using the vehicle covered by the mileage service. The Examiner asserts that Brower discloses all of the features of claim 8. Brower apparently discusses a corporate mileage bank in which the company and the employee split mileage credits, and a corporate passbook in which the credits accrue solely to the company. (Brower; page 1, lines 29-31). Brower does not explicitly discuss subtracting miles from boarding information. The Examiner apparently asserts that Brower's discussion of crediting

**Appl. No. 09/906,995**

miles to a corporate account anticipates the features of claim 8 of subtracting miles from a personal account for a business flight at the time of boarding. Without conceding the veracity of this assertion however, Brower does not disclose or suggest the condition for making the determination of whether usage of the vehicle is covered by the mileage service is for a business of a corporation, namely that the determination is based on a comparison between a working date and a working location of the employee and one of a date of reserving and a period of using the vehicle covered by the mileage service. Therefore, since amended claim 8 recites that the determination is made based on this condition, and since Brower does not disclose this condition, or any discussion at all relating to an evaluation of the time that an employee is working in comparison with the time of traveling. Therefore, the references, alone or in combination, do not render claim 8 unpatentable.

Claims 1-3, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Betting on a quick, decisive battle in the scramble for mileage program members: ANA'S CTI Internet-ready system", Computopia (hereinafter referred to as Computerage), in view of Brower, in view of Unexamined Patent No. 119-34962 (hereinafter referred to as the '962 document), in view of Unexamined Patent No. H1 1-353359 (hereinafter referred to as the '359 document). Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Computerage, Brower, the '962 document, and the '359 document, and further in view of Unexamined Patent No. 2000-132609 (hereinafter referred to as the '609 document). Applicants respectfully traverse all of the obviousness rejections based on the lack of motivation to combine the references.

Claim 1 relates to a system for performing a mileage service depending on a distance traveled by a vehicle. Claim 1 recites, *inter alia*, mileage information storing means adapted to *subtract miles included in said boarding information from accumulated miles of said boarding*

**Appl. No. 09/906,995**

*customer* if said boarding customer is employed by the corporation registered for the corporate mileage service based on said corporation vs. individual relationship information transmitted from said corporation vs. individual relationship information database device, and *add the subtracted miles included in said boarding information to miles of the corporation.*

The Examiner admits that Computerage does not disclose the feature of a database storing a corporation and an individual mileage accounts, nor the feature of subtracting miles from a customer account. (Office Action; page 5, lines 4-9). The Examiner asserts that Brower discloses separate identifiers and accounts and that the '962 document discloses storing personal and business information separately.

The Examiner suggests that the combination of the references is obvious "to track the mileages accrued separately...." and "enabling the corporations to use the accrued mileage from their employees travels on office work and keeping it separate from the employees accrued mileage from their personal travels." (Office Action; page 3-4). Additionally, the Examiner presents various motivations to combine the '962 document, the '359 document, and the '609 document with each other and with Brower and Computerage, for instance to move mileage data from the employee's account to obtained at the time of boarding to the corporation's account so that the corporation gets the benefit (Office Action; page 15, lines 18-20), and to decide if the employee/member can avail of certain corporation/membership benefits or not (Office Action; page 17, lines 17-19).

However each of these motivations appears to arise without any basis except the present application. The Examiner recites advantages achieved by the combination of the references, without showing that a practitioner with ordinary skill in the art and aware of one of any of these references would be motivated to combine the teaching of that reference with any of the other

**Appl. No. 09/906,995**

references. For instance, the Examiner asserts that combining the references "would help in maintaining separate mileage accounts for the corporation and the employee and to add and track the mileages separately" (Office Action; page 3, lines 19-21). However, this merely states an advantage of the present invention, and does not provide a reason, grounded in one of the references, that would motivate one skilled in the art to look to combining the reference with another reference. There is still no citation to any reference provided to demonstrate that these motivations are not the result of hindsight reasoning, and therefore Applicants maintain that the rejection is improper.

The conclusory statements of the Office Action are insufficient to support a claim of obviousness. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either *explicitly or implicitly in the references themselves or in the knowledge generally available* to one of ordinary skill in the art. (MPEP 2143.01, emphasis added). "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Federal Circuit addressed the standard for obviousness and the requirement of motivation in Teleflex, Inc. et al. v. KSR Int'l Co., (119 Fed. Appx. 282; 2005 U.S. App. LEXIS 176). The patent at issue in *Teleflex*, related to an electronic pedal position control and a pedal assembly. In *Teleflex*, the district court granted a motion for summary judgment based on invalidity due to obviousness. The Federal Circuit vacated the decision and remanded to the lower court for further proceedings on the issue of obviousness. The Federal Circuit stated that,

**Appl. No. 09/906,995**

in regard to obviousness, "a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, *but some motivation to combine the prior art teachings in the particular manner claimed.*" (*Teleflex*, citing *In re Kotzab*; emphasis added).

The Federal Circuit found that that there was no motivation to combine the Asano patent, which disclosed all of the limitations except the electronic control, and the Rixon patent, which disclosed an electronic control and an adjustable pedal assembly. As the court further stated:

[t]he district court correctly noted that the nature of the problem to be solved may, under appropriate circumstances, provide a suggestion or motivation to combine prior art references. However, the *test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed.*

(*Teleflex*, citing as background *Rouffei*, 149 F.3d at 1357; emphasis added).

It is respectfully submitted that the present rejection is similar to the rejection discussed in *Teleflex* in that there is no motivation provided in any of Computerage, Brower, the '962 document, or the '359 document to combine its teaching with any of the other references. The Computerage reference apparently discusses mileage credit systems including personal identification cards. However, there is no motivation provided in Computerage to suggest a combination with the corporate mileage bank apparently discussed in Brower. As the *Teleflex* court held, there must be *specific teaching* to motivate a person of ordinary skill in the art must to combine the prior art teachings *in the particular manner claimed*. Therefore, since there is no motivation to combine the references, the rejection is improper, and it is therefore requested that the rejection be withdrawn.

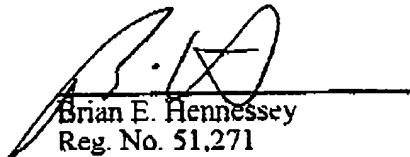
**Appl. No. 09/906,995**

**OCT 12 2006**

In view of the remarks set forth above, Applicants submit that the application is in condition for allowance. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

  
Brian E. Hennessey  
Reg. No. 51,271

CUSTOMER NUMBER 026304  
Telephone: (212) 940-6311  
Fax: (212) 940-8986 or 8987  
Docket No.: NECW 18.854 (100806-00078)  
BEH:pm